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# Fax

**To:** US Patent & Trademark Office **From:** Pat Helton

(1)Nabil El-Hardy &/or (2)John Follansbee

**Fax:** 703-872-9306 **Date:** September 15, 2004

**Phone:** (1)703-308-7990 / (2) 703-305-8498 **Pages:** 7

**Re:** Application 09/811,155 **CC:**

☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

**•Comments:**

As a follow up to the voicemail message left for John Follansbee, please find the following letter specifying election to restriction to Group I in the above-reference application.



September 15, 2004

United States Department of Commerce  
United States Patent and Trademark Office  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
ATTN: Nabil M El-Hady; John Follansbee

SENT VIA FAX: 703-872-9306

Dear Sirs,

We are in receipt of the Office Action Summary, Paper #8 mailed 8/25/04 for Application No. 09/811,155 (a copy follows).

We are not sure why a call to our attorney's office on August 12, 2004 to request an oral election did not result in an election being made.

At this time we would like to make clear that we do elect restriction to Group I – claims 1 – 24 for this application. We will file a new divisional application directed to the claims in Group II.

Should you have any questions or comments in this regard, please do not hesitate to contact me directly at 408-284-6284 or by email at [sandy.helton@sanvalley.com](mailto:sandy.helton@sanvalley.com).

Sincerely,

Sanford L. Helton  
President

6320 San Ignacio Avenue, San Jose, CA 95119 | P 408.284.6200 | F 408.226.5405 | [www.sanvalley.com](http://www.sanvalley.com)

cc: David Jakopin, Pillsbury Winthrop LLP



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,155	03/16/2001	Loren M. Jones	087809 /0269968	5795
27498	7590	08/25/2004	EXAMINER	
PILLSBURY WINTHROP LLP 2475 HANOVER STREET PALO ALTO, CA 94304-1114			EL HADY, NABIL M	
			ART UNIT	PAPER NUMBER
			2134	
			DATE MAILED: 08/25/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/811,155

**Applicant(s)**

JONES ET AL.

**Examiner**

Nabil M El-Hady

**Art Unit**

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/16/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTC-949)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to multiple computer data transferring / computer-to-computer data framing, classified under class 709, subclass 236.
- II. Claims 25-34, drawn to transfer data counting, classified under class 710, subclass 34.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as multiple computer data transferring / computer-to-computer data framing, lacking one or more of the particulars of invention II. Invention II has separate utility such as transfer data counting implementation between computers or processing systems, lacking one or more of the particulars of invention I. See MPEP § 806.05 (d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. A telephone call was made to David A. Jakopin on August 12, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. A shortened statutory period for response to this action is set to expire 0 (zero) months and 30 (thirty) days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, MPEP 710.02, 710.02(b)).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

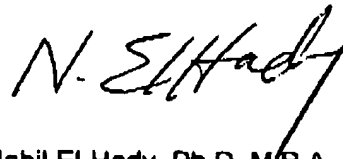
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 17, 2004



Nabil El-Hady, Ph.D, M.B.A.  
Primary Patent Examiner  
Art Unit 2154